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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,812	08/05/2003	Martin L. Hage	110000-9410	8827

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EXAMINER

SHOSHO, CALLIE E

ART UNIT PAPER NUMBER

1714

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,812

Applicant(s)

HAGE, MARTIN L.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/17/06 has been entered.

2. All outstanding rejections are overcome by applicants' amendment filed 5/17/06.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 14 were each amended to recite that the ink is “non-permanent”. The cited phraseology clearly signifies a “negative” or “exclusionary” limitation for which the applicants have no support in the original disclosure. Negative limitations in a claim which do not appear in the specification as filed introduce new concepts and violate the description requirement of 35 USC 112, first paragraph, *Ex Parte Grasselli, Suresh, and Miller*, 231 USPQ 393, 394 (Bd. Pat. App. and Inter. 1983); 783 F. 2d 453.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites “said coloring vehicle including a surfactant and coupling tail solvent sufficient to wet and adhere said ink to said ophthalmic ink to an ophthalmic lens”. The scope of the claim is confusing because it is not clear what the difference is between “said ink” and “said ophthalmic ink” or how the ink is adhered to the ophthalmic ink. Should “said ink to” be deleted from the above phrase?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1714

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 9-10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/41180 taken in view of the evidence given in Asao et al. (U.S. 4,085,949)

WO 97/41180 discloses waterborne ophthalmic marking ink comprising 20-50% water and colorant, i.e. 5-45% titanium dioxide and 0.25-7.5% dye including tartrazine dye which is well known, as evidenced by Asao et al. (col.5, lines 53 and 61), as an azo dye. The ink is applied to ophthalmic lens for purpose of marking the lens. It is disclosed that the ink is removable, i.e. non-permanent. Further, given that the ink utilizes titanium dioxide, it is clear that the ink is opaque (page 1. lines 3-9, page 2, lines 23-26, page 3, lines 1-3 and 8-12, page 4, lines 10-18, page 7, lines 3-15, page 8, lines 4-13 and 19-21, and page 9, lines 27-28).

In light of the above, it is clear that WO 97/41180 anticipates the present claims.

9. Claims 1, 9, and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Imagawa et al. (U.S. 5,716,217)

Imagawa et al. disclose erasable, i.e. non-permanent, ink comprising not less than 50% water, 0.5-30% film-forming resin, i.e. binder, such as vinyl acetate, alkyd or polyurethane, not more than 20% pigment including carbon black, not more than 20% polyhydric alcohol, i.e. coupling tail solvent, such as ethylene glycol, 0.2-5% anionic or nonionic surfactant, and pH

controller (col.1, lines 9-12, col.2, lines 28-46, col.3, lines 29-33 and 47-49, col.4, lines 1-51, col.5, line 51-col.6, line 4, and col.6, lines 31-34). Given that the ink utilizes carbon black, it is clear that the ink is opaque. Further, given that Imagawa et al. disclose amounts of surfactant and solvent as presently claimed, it is clear that the surfactant and solvent are sufficient to inherently wet and adhere the ink to an ophthalmic lens as presently claimed (claims 14-16).

While there is no disclosure that the ink is an “ophthalmic marking ink” as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner’s position that the preamble does not state any distinct definition of any of the claimed invention’s limitations and further that the purpose or intended use, i.e. ophthalmic marking ink, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art ink and further that the prior art structure which is a non-permanent, opaque ink as set forth in the present claims is capable of performing the recited purpose or intended use.

In light of the above, it is clear that Imagawa et al. anticipate the present claims.

10. Claims 1 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller et al. (U.S. 6,174,938).

Miller et al. disclose removable, i.e. non-permanent, opaque ink comprising 40-75% water and 0.1-30% colorant that is pigment such as carbon black (col.2, lines 9-10, 25-26, and 45-55, col.5, line 66-col.6, line 36, col.6, line 63-col.6, line 12, and col.10, lines 34-61).

While there is no disclosure that the ink is an “ophthalmic marking ink” as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner’s position that the preamble does not state any distinct definition of any of the claimed invention’s limitations and further that the purpose or intended use, i.e. ophthalmic marking ink, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art ink and further that the prior art

structure which is a non-permanent, opaque ink as set forth in the present claims is capable of performing the recited purpose or intended use.

In light of the above, it is clear that Miller et al. anticipate the present claims.

11. Claims 1 and 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshimura et al. (U.S. 6,497,759).

Yoshimura et al. disclose removable, i.e. non-permanent, opaque ink comprising 50-90% solvent including water and organic solvent, i.e. coupling tail solvent, such as glycols, 0.01-30% film-forming resin, i.e. binder obtained from styrene, acrylic, etc., base, surfactant, and 1-10% colorant that is pigment such as anthraquinone or phthalocyanine (col.1, lines 11-16, col.2, lines 16-18, col.3, lines 35-39 and 55-58, and col.4, lines 17-20, 30-33, 43-51, and 60-64).

While there is no disclosure that the ink is an “ophthalmic marking ink” as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. ophthalmic marking ink, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art ink and further that the prior art structure which is a non-permanent, opaque ink as set forth in the present claims is capable of performing the recited purpose or intended use.

In light of the above, it is clear that Yoshimura et al. anticipate the present claims.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/41180 in view of Souel et al. (U.S. 6,281,468).

The disclosure with respect to WO 97/41180 in paragraph 8 above is incorporated here by reference.

The difference between WO 97/41180 and the present claimed invention is the requirement in the claims of (a) cleaning the lens surface with aqueous media and drying before applying ink and (b) treating lens surface with corona discharge.

With respect to difference (a), WO 97/41180 disclose applying ink to ophthalmic lens using pad printing, however, there is no disclosure in WO 97/41180 of first cleaning and drying the lens. However, it would have been within the skill level of one of ordinary skill in the art to clean and dry the lens before applying ink in order to ensure that ink is applied to surface without dirt or moisture and thus ensure that the ink is able to adhere to the lens as well as remain adhered.

With respect to difference (b), Souel et al. disclose subjecting contact lens to be marked with corona discharge in order to increase surface energy and thereby improve adherence of the surface to be marked (col.1, lines 54-60 and col.5, lines 18-23).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to clean the contact lens with aqueous media and dry the contact lens followed by applying corona discharge to the surface of the lens of WO 97/41180 before applying ink in order to produce contact lens wherein the ink is easily applied to the lens and remains firmly adhered, and thereby arrive at the claimed invention.

14. Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imagawa et al. (U.S. 5,716,217) in view of WO 95/01392.

The disclosure with respect to Imagawa et al. in paragraph 9 above is incorporated here by reference.

The difference between Imagawa et al. and the present claimed invention is the requirement in the claims of specific type and amount of pH controller, i.e. neutralizing base.

WO 95/01392, which is drawn to removable ink, discloses the use of 0.1-5% base such as sodium hydroxide or potassium hydroxide in order to control the pH of the ink and make the ink water washable as well as dry wipeable (page 6, lines 6-23).

In light of the motivation for using specific type and amount of base disclosed by WO 95/01392 as described above, it therefore would have been obvious to one of ordinary skill in the art to use such base as the pH controller in Imagawa et al. in order to produce ink with desired pH that is water washable as well as dry wipeable, and thereby arrive at the claimed invention.

15. Claims 2 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imagawa et al. (U.S. 5,716,217) in view of WO 95/01392 and Nakamura et al. (U.S. 4,935,461).

The disclosure with respect to Imagawa et al. in paragraph 9 above is incorporated here by reference.

The difference between Imagawa et al. and the present claimed invention is the requirement in the claims of (a) amount of pH controller, i.e. neutralizing base and (b) specific surfactant.

With respect to difference (a), WO 95/01392, which is drawn to removable ink, discloses the use of 0.1-5% base in order to control the pH of the ink and make the ink water washable as well as dry wipeable (page 6, lines 6-23).

With respect to difference (b), Nakamura et al., which is drawn to removable ink, disclose the use of surfactant including perfluorinated surfactant and acetylene alcohol in order to increase the wettability of the ink onto the substrate (col.2, lines 30-35 and 41-46).

In light of the motivation for using specific amount of base disclosed by WO 95/01392 and for using specific surfactant disclosed by Nakamura et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such amount of base or pH controller in Imagawa et al. in order to produce ink with desired pH that is water washable as well as dry wipeable and to use such surfactant as the surfactant in Imagawa et al. in order to produce ink with increased wettability, and thereby arrive at the claimed invention.

16. Claims 2-3, 7-8, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura et al. (U.S. 6,497,759) in view of Takemoto et al. (U.S. 2005/0143490) and either Sukhna et al. (U.S. 6,224,284) or Fraas (U.S. 5,961,703).

The disclosure with respect to Yoshimura et al. in paragraph 11 above is incorporated here by reference.

The difference between Yoshimura et al. and the present claimed invention is the requirement in the claims of (a) specific type and amount of surfactant and (b) specific amount of base.

With respect to difference (a), it is noted that Yoshimura et al. disclose the use of surfactant, however, there is no disclosure of the type or amount utilized.

Takemoto et al., which is drawn to ink, disclose the use of 0.1-10% acetylene glycol as penetrating agent (paragraphs 45, 48, and 51).

With respect to difference (b), it is noted that Yoshimura et al. disclose the use of base, however, there is no disclosure of the amount utilized.

Sukhna et al., which is drawn to ink, disclose the use of 0.25-1% base such as triethanolamine in order to avoid buildup of gas associated with the use of aluminum flakes (col.3, lines 45-55 and col.5, lines 1-6) as disclosed by Yoshimura et al.

Alternatively, Fraas, which is drawn to ink, disclose the use of 0.1-0.6% triethanolamine in order to avoid problems in writing tip of pen that utilizes the ink (col.5, lines 20-25).

Given that Yoshimura et al. in combination with Takemoto et al. and either Sukhna et al. or Fraas et al. disclose ink as presently claimed including the use of surfactant and base as presently claimed, it is clear that the surfactant and solvent are sufficient to inherently wet and adhere the ink to an ophthalmic lens as presently claimed (claims 14-16).

In light of the motivation for using specific type and amount of surfactant and base disclosed by Takemoto et al. and either Sukhna et al. or Fraas, it therefore would have been obvious to one of ordinary skill in the art to use such surfactant and base in the ink of Yoshimura et al. in order to produce ink with good penetration into substrate as well as to avoid buildup of hydrogen gas or, alternatively, avoid writing problems, and thereby arrive at the claimed invention.

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Similar to Imagawa et al. (U.S. 5,716,217) utilized above, each of Nakamura et al. (U.S. 5,854,320) and Li (U.S. 2003/0171453) disclose erasable ink comprising water and colorant as presently claimed, however, no disclosure that the ink is ophthalmic marking ink.

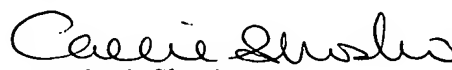
WO 92/20750 discloses removable ink comprising 5-30% pigment and 20-70% water.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CS
7/29/06


Callie E. Shosho
Primary Examiner
Art Unit 1714